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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,729	02/06/2004	Andrew R. Forrest	FPC001USU	8604
45180	7590	11/23/2004	EXAMINER	
GRIMES & BATTERSBY, LLP 488 MAIN AVENUE, THIRD FLOOR NORWALK, CT 06851			MENDIRATTA, VISHU K	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/773,729

Applicant(s)

FORREST ET AL.

Examiner

Vishu K Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) 14 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8, 12, 13 and 15 is/are rejected.  
7) ☒ Claim(s) 9-11 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 15, drawn to Board games, classified in class 273, subclass 254.
  - II. Claim 14, drawn to Puzzle, classified in class 273, subclass 153.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are Board games (I) and Puzzle (II).
3. During a telephone conversation with attorney James Coplit on 11/17/04 a provisional election was made without traverse to prosecute the invention of Board games , claims 1-13 and 15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 14 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Specification***

4. The disclosure is objected to because of the following informalities: **Entire disclosure requires reviewing for typing errors. For example “robot car” v/s “robot card” at various locations in disclosure. For example, page 16, line 9-10, one of the die “42” should be “44”.**

Appropriate correction is required.

***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **ROBOT CAR/CARD/CART (?)** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

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description: **24,34,62**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 12,15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether "robot car" or "robot cart" is being claimed.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 1,2,3,7,8,13 rejected under 35 U.S.C. 102(b) as being anticipated by Snyder (3,734,508).

Claim 1: Snyder teaches a game board (12), at least two player game pieces (33) and a timing mechanism (24).

Claims 2,13: Snyder teaches a non-player game piece (29), capable of being placed on the board and also influencing the movement of game pieces (2:43-47). A non-player game piece is being interpreted as a piece that is not owed/controlled by any one player. It can also be interpreted as a game piece that is being commonly used by all players broadly and reasonably interpreting. Also a movement such as spinning by a spinner or a movement of rolling by a die can be interpreted as movement of a non-player piece broadly and reasonably interpreting. The claim does not however specifically limit the movement of such a non-player piece on a path of individual spaces.

Claim 3: Snyder teaches a die (37).

Claim 7: Lockable mechanism (31) and a key (36) to open the mechanism.

Claim 8: Both lockable mechanism and timing device within the same game board unit (12,24,31).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1,2,13 rejected under 35 U.S.C. 103(a) as being unpatentable over Ferris (4498674).

Claims 1,2,13: Ferris teaches playing pieces (40) and non-playing pieces (50).

Ferris teaches keeping a track of time (5:20-25) but does not expressly teach providing a timing device. In order to keep a track of time, it would have been obvious to use a timer. One of ordinary skill in art at the time the invention was made would have suggested using a timer.

13. Claim 3-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Ferris in view of Hayes (3649021).

Claim 3: Ferris teaches all limitations except that it does not teach dice. Hayes teaches a dice. Dice is an art recognized equivalent for spinner and are used for random selection just like a spinner would do. One of ordinary skill in art at the time the invention was made would have suggested using a dice for spinner.

Claim 4: Ferris teaches all limitations except that it does not teach playing pieces in various shapes. Hayes teaches playing pieces in all possible shapes (2:40-43). Art area of game board is a very competitive amusement area and in order to attract players it has been a common practice to provide playing pieces that affect other game pieces. In order to make the game attractive, it would have been obvious to provide such game pieces. One of ordinary skill in art at the time the invention was made would have suggested using game pieces influencing other game pieces.

Claims 5-6: Ferris teaches spaces on a path (16,18).

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14. Claims 2-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of Bedford (US 2003/0085519 A1).

Claim 2,5,6: Snyder teaches a game board (12), at least two player game pieces (33) and a timing mechanism (24). Snyder teaches discrete spaces/chambers (14,19,20,21). Snyder teaches all limitations except that it does not expressly teach a non-player game piece with regards to its movement on a path of spaces. A non-player game piece is being interpreted as a piece that is not owed/controlled by any one player. It can also be interpreted as a game piece that is being commonly used by all players broadly and reasonably interpreting.

Also a movement such as spinning by a spinner or a movement of rolling by a die can be interpreted as movement of a non-player piece broadly and reasonably interpreting. The claim does not however specifically limit the movement of such a non-player piece on a path of individual spaces.

Bedford teaches a non-player piece (138) that influences movement of player pieces (134) (see paragraph 0064, the Malfoy movement influencing player pieces).

Art area of game board is a very competitive amusement area and in order to attract players it has been a common practice to provide playing pieces that affect other game pieces. In order to make the game attractive, it would have been obvious to provide such game pieces. One of ordinary skill in art at the time the invention was made would have suggested using game pieces influencing other game pieces.

Claim 3: Snyder teaches use of a die (37).



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Claim 4: Changing shapes of playing pieces is aesthetical and do not change the game. In order to attract players, it would have been obvious to use various shapes of playing pieces.

***Allowable Subject Matter***

15. Claims 9-11 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

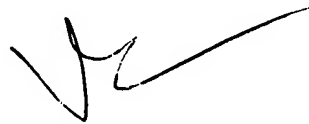
17. Claim 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K Mendiratta  
Primary Examiner  
Art Unit 3711

VKM

November 18, 2004